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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,278	08/10/2000	Gholam-Reza Zadno-Azizi	PERCUS.1CP2C1	7079
20995	7590	02/08/2005		
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
			EXAMINER BIANCO, PATRICIA	
			ART UNIT 3762	PAPER NUMBER

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/636,278	Applicant(s) ZADNO-AZIZI ET AL.	
	Examiner Patricia M Bianco	Art Unit 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-49, 51-56 and 58-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43, 44, 48, 49, 51-56 and 58-64 is/are rejected.
- 7) ☒ Claim(s) 45-47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Detailed Action</u> . |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 22nd, 2004 has been entered.

Response to Amendments

The amendment filed along with the RCE amended claims 43, 48, 49, 51, 52, 53, and 55. Claims 43-49, 51-56 & 58-64 remain pending.

Response to Arguments

Applicant's arguments with respect to claims 43-49, 51-56, and 58-64 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 49 recites the limitation "said resilient material" in line 1 of the claim.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 43, 44, 48, 49, 51-56, & 58-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel et al. (6,001,118) in view of Guenther et al. (5,102,415).

Daniel et al. disclose a device having a tubular member (124) having an expandable member (130) disposed at its distal end, an elongate member (132) that is connected to the expandable member at its distal end and extends longitudinally within the lumen of the tubular member. The elongate member is a microporous membrane, braided structure, or filter assembly. The elongate member is moved longitudinally from a first position (see figure 13A) to a second position (see figure 13B) to cause the expandable member to move from its closed configuration into its expanded configuration. During the expansion, the elongate member is pulled back, or retracted. The device further comprises a lock mechanism (134) to keep the expandable member in its expanded configuration. (See col. 8, lines 3-50) Daniel et al. further teaches that the expandable member may have a mesh (144) covering the expandable member, and the mesh may be provide a resilient memory (see col. 8, lines 51-65).

Daniel et al. discloses the invention substantially as claimed, see rejection supra, however, fails to disclose specifically that the covering is entirely over the mesh, thereby

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completely occluding the blood flow in the vessel and does not specifically teach that the elongate member has a diameter of "about 0.006 to 0.008 inches."

With respect to the diameter range, Daniel et al. teaches that the elongate member has a size based on the order of a guidewire, such as a 0.014 inch diameter (col. 8, lines 24-26). It would have been an obvious matter of design choice to modify the elongate member to have a size of about 0.006 to 0.008 inches, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Guenther et al. (hereafter Guenther '415) discloses an apparatus comprising a tubular member having a self-expanding braid structure disposed on its distal extremity. The braid structure may have an outer coating/membrane or covering thereon that covers the entire braided expandable structure (see fig. 5). Said complete covering is a membrane covering being configured to completely occluding blood flow in the vessel. At the time of the invention, it would have been obvious to one having skill in the art at the time of the invention to modify the expandable member of Daniel to include an outer covering completely covering the structure as taught by Guenther, since the covering will obviously provide complete occlusion of blood flow in a vessel

Allowable Subject Matter

Claims 45-47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

With respect to claim 45, the subject matter not found was the limitation wherein the elongate member rotates to position the expandable member in its locked, expanded configuration in combination with the other elements (or steps) in the claims.

With respect to claim 46, the subject matter not found was the limitation wherein the elongate member rotates approximately 90 degrees to position the expandable member in its locked, expanded configuration in combination with the other elements (or steps) in the claims.

With respect to claim 47, the subject matter not found was the limitation wherein rotation of the elongate member causes a portion connected to the elongate member to engage a portion connected to the tubular member in combination with the other elements (or steps) in the claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Halpern (5,749,883) and Chin et al. (6,344,048) disclose analogous occlusion devices having braided expandable member structures that may have a coating or covering thereon.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia M Bianco whose telephone number is (571) 272-4940. The examiner can normally be reached on Monday to Friday 9:00-6:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 4th, 2005


PATRICIA BIANCO
PRIMARY EXAMINER

Patricia M Bianco
Primary Examiner
Art Unit 3762